

REMARKS

The present amendments and remarks are in response to the Office Action of February 22, 2006. Claims 1- 30 are currently pending.

Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, the Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the Office Action, the following rejections were issued:

- (1) Claims 9, 19, and 29 were rejected under 35 U.S.C. 112 as being indefinite;
- (2) Claims 1-5, 9-10, 21-25, and 29-30 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Application No. 2005/0027035 (hereinafter "Wang");
- (3) Claims 1 and 21 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,846,307 (hereinafter "Nagasawa") taken in view of U.S. Patent No. 5,929,876 (hereinafter "Bartolome");
- (4) Claims 1-3 and 21-23 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Application No. 2002/0107303 (hereinafter "Miyabayashi");
- (5) Claims 1-4 and 21-24 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,948,155 (hereinafter "Yui");
- (6) Claims 4-5 and 24-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi in view of U.S. Patent No. 6,280,513 (hereinafter "Osumi").
- (7) Claims 5 and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yui in view of Osumi;
- (8) Claims 6 and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yui in view of U.S. Application No. 2003/0196569 (hereinafter "Yatake");
- (9) Claims 7-8 and 27-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi or Yui either of which in view of U.S. Patent No. 6,874,881 (hereinafter "Suzuki");
- (10) Claims 11-13 and 17-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi in view of Suzuki and Bartolome;

- (11) Claims 14-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi in view of Suzuki and Bartolome as applied to claims 11-13 and 17-18, and further in view of Osumi;
- (12) Claims 11-14 and 17-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yui in view of Suzuki;
- (13) Claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over Yui in view of Suzuki as applied to claims 11-14 and 17-18, and further in view of Osumi;
- (14) Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yui in view of Suzuki as applied to claims 11-14 and 17-18, and further in view of Yatake;
- (15) Claims 1-3, 6, 21-23, and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,889,083 (hereinafter "Zhu") in view of Yatake and Bartolome;
- (16) Claims 4-5 and 24-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhu in view of Yatake and Bartolome as applied to claims 1-3, 6, 21-23, and 26, and further in view of Osumi;
- (17) Claims 7-8 and 27-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhu in view of Yatake and Bartolome as applied to claims 1-3, 6, 21-23, and 26, and further in view of Suzuki;
- (18) Claims 11-13 and 16-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhu in view of Yatake, Suzuki, and Bartolome;
- (19) Claims 14-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhu in view of Yatake, Suzuki, and Bartolome as applied to claims 11-13 and 16-18, and further in view of Osumi; and
- (20) Claims 11-15 and 17-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Suzuki and Bartolome.

Rejections under 35 U.S.C. 112, second paragraph

The Examiner has rejected claims 9, 19, and 29 under 35 U.S.C. 112, second paragraph as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended the claims, as advised by the Examiner, by replacing the abbreviation "TRIS" with the actual chemical name. Accordingly, the Applicant respectfully requests that this rejection be withdrawn.

Rejections under 35 U.S.C. 102

Before discussing the 35 U.S.C. 102 rejections, it is thought proper to briefly state what is required to sustain such a rejection. It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.* 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Claims 1-5, 9-10, 21-25, and 29-30 were rejected under 35 U.S.C. 102(e) as being anticipated by Wang. The Examiner also rejected several of these same claims as being anticipated by Nagasawa, Miyabayashi, and Yui under 102(b). As amended, Wang and the other references do not disclose each and every element of the claims in the instant application. For example, none of the references suggest a system for printing images on a substrate that includes a printhead configured for jetting ink-jet ink at a firing frequency from 12 kHz to 25 kHz as required by claim 1 as currently amended. It is noted that claim 7, which is now present in claim 1, was not rejected under this section, and thus, all rejections under this section have been rendered moot. Additionally, Nagasawa, Miyabayashi, and Yui do not disclose ink-jet inks having at least three of 1,2-pentanediol, ethoxylated glycerol, 1,2-pyrrolidinone, and 2-methyl-1,3-propanediol. Accordingly, the Applicants respectfully request that the above rejections be withdrawn.

Rejections under 35 U.S.C. 103(a)

Before discussing the rejections under 35 U.S.C. 103(a), it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether

the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing some motivation in a prior art reference to modify that reference, or combine that reference with multiple references, to teach all the claim limitations in the instant application. Applicants respectfully assert the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in this rejection.

The obviousness rejections of claims 1-8, 11-18, and 21-28 based on various combinations of Miyabayashi, Osumi, Yui, Yatake, Suzuki, Batolome, and Zhu do not establish a case of *prima facie* obviousness because none of these references teach each and every claim limitation of the instant application. Specifically, none of the abovementioned references teach or suggest modifying an ink to include at least three of 1,5-pentanediol, ethoxylated glycerol, 1,2-pyrrolidinone, and 2-methyl-1,3-propanediol in the organic solvent content, as required by the amendments to claims 1, 11, and 21. It is noted that none of these references were used to reject claim 10, and thus, rejections cited using these references have been rendered moot. Because none of these references teach or suggest modifying an ink to include each and every claim limitation, Applicant respectfully requests that the obviousness rejections based on these references be withdrawn.

Wang and the instant invention are subject to an obligation of assignment to the same person; therefore Wang cannot preclude patentability under section 103. Claims 11-15 and 17-20 were rejected under 103(a) as being unpatentable over Wang in view of Suzuki and Bartolome. 35 U.S.C. § 103(c)(1) states "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Wang qualifies as prior art only under subsection (e) of section 102 because it is a patent application publication, thus the first prong of 103(c)(1) is clearly met. The second prong is also met because the inventors of both Wang and the instant application have an obligation of assignment to the same company, Hewlett-Packard. Accordingly, Applicants respectfully request that the obviousness rejections of claims 11-15 and 17-20 based on the Wang reference be withdrawn. Additionally, the subject

matter of claim 10 has been included in all of the independent claims, thus rendering this rejection moot for this secondary reason.

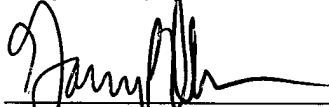
CONCLUSION

In view of the foregoing, Applicants believe that claims 1-29 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains, and such impediment could be resolved during a telephone interview, the Examiner is invited to telephone the assignee's counsel, W. Bradley Haymond at (541) 715-0159, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 17th day of May, 2006.

Respectfully submitted,



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